

PATENT  
ATTORNEY DOCKET NO.: 040894-7374

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:	)	
	)	
Tatsushi OGAWA et al.	)	Confirmation No.: 1486
	)	
Application No.: 10/564,761	)	Group Art Unit: 3721
	)	
Filed: January 17, 2006	)	Examiner: Lindsay M. Low
	)	
For: CYLINDRICAL CONTACT ARM	)	<b>Mail Stop Appeal Brief Patents</b>
HAVING TAPERED GUIDE SECTION	)	
IN A POWER-DRIVEN NAILING	)	
MACHINE (As Amended)	)	

Commissioner for Patents  
**Mail Stop Appeal Brief Patents**  
Alexandria, VA 22314

**APPELLANTS' REPLY BRIEF UNDER 37 C.F.R. § 41.41**

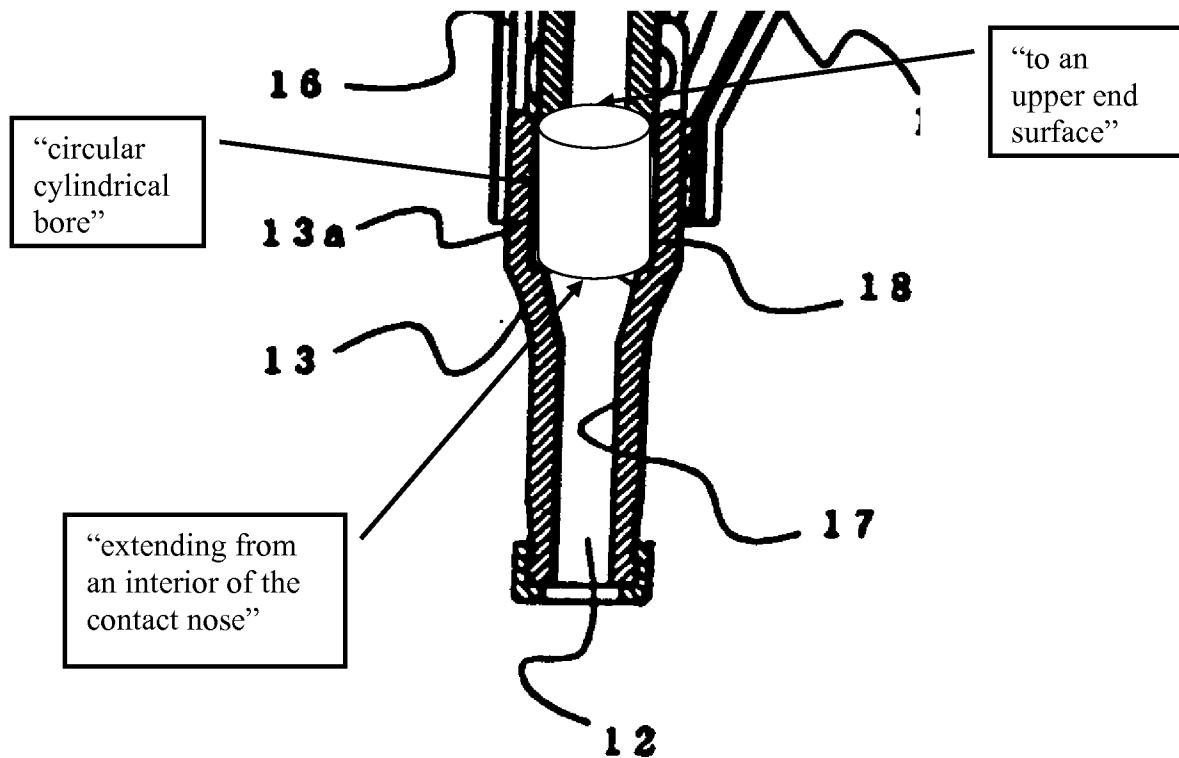
Appellants filed a Notice of Appeal on October 8, 2009, and their brief on November 30, 2009. This Reply Brief responds to the arguments raised in the Examiner's Answer mailed February 18, 2010, and is timely filed on or before April 18, 2010.

## **ARGUMENT**

Appellants respectfully maintain that the rejections under 35 U.S.C. §§ 102(b) and 112 are improper and should be reversed for the reasons set forth in the Appellants' Brief filed November 30, 2009. In addition to the arguments presented in the Appellants' Brief, Appellants assert that the Examiner's arguments presented in the Examiner's Answer mailed February 18, 2010 are erroneous in at least two key respects, addressed below.

### **I. Claims 1 And 3-7 Are Not Indefinite**

With respect to independent claim 1, the Examiner alleges that the feature "the circular cylindrical bore extending from an interior of the contact nose" is unclear. Examiner's Answer, p. 7. Specifically, the Examiner alleges "It is unclear how the cylindrical area is extending from an *interior* of the contact nose." *Id.* (emphasis in original). Appellants submit that a bore may extend from an interior of an object. Appellants use the figure below to clarify.

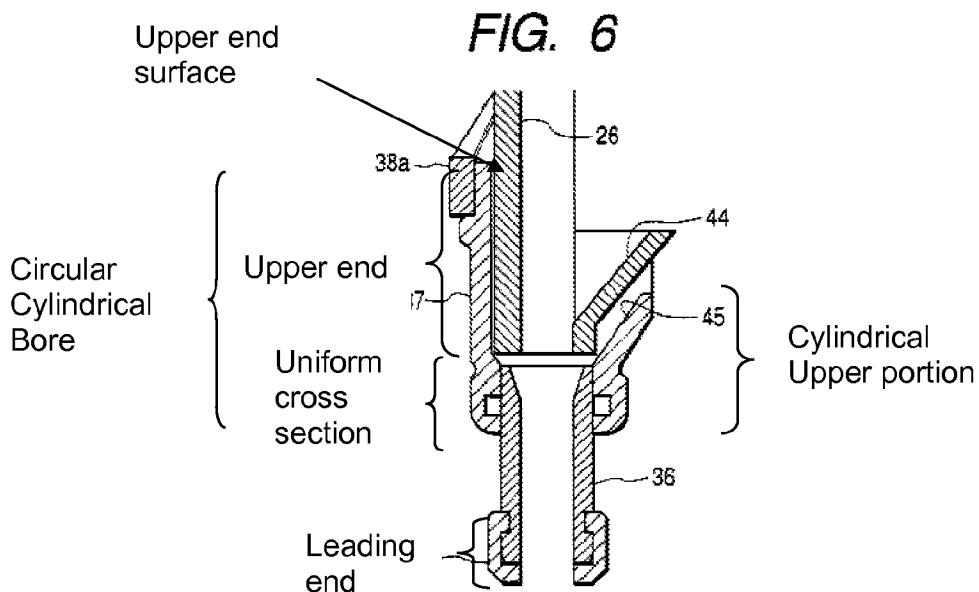


The figure above, taken from Figure 2 of the present application, shows an exemplary contact nose 13 and an exemplary circular cylindrical bore 13a. A cylinder has been superimposed for illustrative purposes. Contact nose 13, like all solid objects, has three spatial dimensions. It has a height, a width, and a depth. Circular cylindrical bore 13a extends from an interior of contact nose 13 to an upper end surface. The “interior” of the contact nose is a location inside the contact nose 13 in all three spatial dimensions. That is, it is between the upper most and lower most portions of the contact nose 13 in a height dimension, between the left most and right most portions in a width dimension, and between the fore most and rear most portions in a depth dimension.

For the above reasons, a bore may extend from an interior of an object. Accordingly, the phrase “the circular cylindrical bore extending from an interior of the contact nose” is not unclear.

**II. Kubo Fails To Disclose The Feature “A Circular Cylindrical Bore Having . . . A Substantially Uniform Cross Section”**

The Examiner alleges that *Kubo* discloses the feature “a circular cylindrical bore having . . . a substantially circular cross section.” Specifically, the Examiner provides the annotated figure below.



The portion designated “Circular Cylindrical Bore” is not a circular cylindrical bore for at least two reasons. First, it is not “circular.” The Examiner alleges that the portion designated “Circular Cylindrical Bore” is “certainly circular, as it defines a round closed loop portion.” Examiner’s Answer, p. 7. This interpretation of the word “circular” is too broad. *See* The American Heritage College Dictionary 261 (4th ed. 2007) (providing as a first definition of “circle” the following: “A plane curve everywhere equidistant from a given fixed point, the center”). The Examiner also states that “an object can still be ‘circular’ even if it does not form an absolute perfect circle.” *Id.* While Appellants will not address whether this assertion is true, Appellants assert that the object must have some resemblance to a circle in order to be considered “circular.” The feature of *Kubo* alleged to be a circular cylindrical bore contains pronounced guide grooves 43 and an escape opening 45. *See Kubo*, Figs 5 and 6. These features prevent the alleged circular cylindrical bore from being “circular” or even approximately circular.

Second, the portion designated “Circular Cylindrical Bore” does not have a “substantially uniform cross section.” The Examiner seems to take the position that the feature is met so long as only a portion of the circular cylindrical bore has a substantially uniform cross section. Appellants respectfully disagree. The Examiner’s position improperly reads the feature out of the claim. In any bore, cross sections taken very near each other are close to uniform. Accordingly, under the Examiner’s interpretation, any bore satisfies this feature. In other words, the Examiner’s position reads the feature “substantially uniform cross section” out of the claim. Therefore, the cross section of the circular cylindrical bore must be substantially uniform throughout its entire length. *Kubo* fails to disclose this feature, as the Examiner appears to concede.

Figures 5 and 6 of *Kubo* show that what is alleged to be a “Circular Cylindrical Bore” by the Examiner does not have a uniform cross section along its entire length. Further, the Examiner appears to concede this point. The Examiner designates only a portion of what is designated “Circular Cylindrical Bore” as “Uniform cross section.” Further, the Examiner alleges “the ‘circular cylindrical bore’ designated by the examiner is certainly circular, as it defines a round closed loop portion (*especially where it is a uniform cross section*).” Examiner’s Answer, p. 7 (emphasis added). By alleging a feature is met *especially* where there is a uniform cross section, the Examiner appears to concede that there is a portion where there is not a uniform cross section.

Furthermore, the portion alleged to be of a substantially uniform cross section is not part of a circular cylindrical bore as claimed. As claimed, the nose body is housed in the circular cylindrical bore. The Examiner alleges that nose 26 of *Kubo* is a nose body as claimed.

However, as is shown in Fig. 6 of *Kubo* and the annotated figure provided by the Examiner, the portion alleged to have a uniform cross section does not house nose 26.

For the reasons above, the portion alleged to be a “Circular Cylindrical Bore” is not circular and does not have a substantially uniform cross section, as claimed.

In view of the foregoing, Appellants respectfully request the reversal of the Examiner’s rejections and the allowance of the pending claims. If there are any other fees due in connection with the filing of this Reply Brief, please charge the fees to our Deposit Account No. 50-0310.

Respectfully submitted,  
**MORGAN LEWIS & BOCKIUS LLP**

Dated: April 15, 2010

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